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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,772	01/16/2001	Daniel S. Bricklin	85151.911CPAC	8917

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EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,772

Applicant(s)

BRICKLIN ET AL.

Examiner

Stephen S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. This office action is responsive to amendment filed on September 22, 2003. As requested by Applicant in the amendment, this action clarifies the rejection that appears to be incomplete in the previous Office Action.

2. Claims 70 and 71 are added. Accordingly, claims 1-71 are pending. Claims 40-42 and 58-60 have been elected without traverse. The remaining claims are withdrawn from consideration.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 70 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 70 and 71, the limitation "capturing prominent features" is indefinite, since the term "prominent" is subjective in nature, and thus, what may be considered prominent by one may not be considered prominent by others.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 40-42 and 58-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Gentner (5,724,595).

7. Claims 40-42, 58-60, 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentner (5,724,595).

Regarding independent claims 40 and 58, refer to Gentner's abstract, figures 2-4, and column 2 (line 63) through column 4 (line 19). Gentner discloses:

"creating a link between a first lexia and a second lexia". See abstract, in which he discloses *creating a link in an original hypertext document to a target hypertext document*.

"displaying a first lexia in a lexia display window on a display screen". See figure 2 (10).

"displaying a graphical element representing a second lexia in a hypermedia work display window on said display screen." See figures 2 and 3—anchor icon. The hypermedia work display window includes the entire display (14).

"selecting a location for an activation area for a link in said lexia display window". See figure 2 (16).

"selecting said graphical element in said hypermedia work display window". See column 3 (top), in which he discloses *control icons 18, called the "drag icons", which in the preferred embodiment is a representation of a ship's anchor*. Refer also to column 3 (lines 34-55), in which Gentner discloses *moving the mouse cursor over the drag target in the control area of the target window and pressing the select button on the mouse*.

With respect to the limitation, "wherein said hypermedia display window is configured to **act on** at least said first lexia and said second lexia", the inclusion of both first and second "lexia" (10 and 12 in figures 2 and 3) within the display window (14) of Gentner inherently shows that the window "acts on" the "first and second lexia." The "act" of displaying both first and second "lexia" constitutes "acting on" them.

Regarding dependent claims 41-42 and 59-60, refer to Gentner's figure 3 (20) and column 3 (lines 51-54), in which he discloses "extracting a label", and "said link activation area comprises said label"--*the title of the target page is inserted into the text of the original page at the location of the mouse pointer*.

As per dependent claims 70 and 71, Gentner discloses obtaining the graphical element by capturing prominent features of the second lexia (col.3, lines 2-6), since the ship's anchor representation captures the feature of the second lexia document being the anchor target.

Response to Arguments

8. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

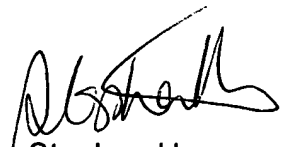
In the Applicant's argument on pages 3 and 4 of the amendment, Applicant argues that "In Gentner the same icon (e.g., a ship's anchor) is utilized to indicate a link's location to a target document and does not provide a distinctive visual cue of the target page because the icon is a representation of a link rather than a representation of the media work. Gentner does not provide a graphical element that is caricature of the target page. In Gentner, the graphical representation is not algorithmically generated to show a target lexia's prominent features." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies above (i.e., "caricature of the target page", "target lexia showing prominent features" etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). What is in fact claimed is the feature of "displaying a graphical element individually representing a second lexia

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in a hypermedia work display window on said display screen." This is exactly what is disclosed by Gentner in Figure 2. Note that the "12c" is a control area individually represented for the specific document "12" which is at "http://www.acme.com/ete./ab.html." Note that the anchor icon in 12c of Figure 2 individually represents the target document "GOOD IDEA" at http://www.acme.com/ete./ab.html. In other words, for another target document, a different control area "12c" will include another anchor icon that will individually represent the specific target document. Clearly, Gentner discloses the invention as claimed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Stephen Hong
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December 14, 2003